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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/626,270

07/24/2003

Satoshi Yamashita

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9594

24978

7590

08/31/2006

GREER, BURNS & CRAIN  
300 S WACKER DR  
25TH FLOOR  
CHICAGO, IL 60606

EXAMINER

DINH, TAN X

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/626,270

Applicant(s)

YAMASHITA, SATOSHI

Examiner

TAN X. DINH

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

1) This application is a CONTINUATION Application of PCT/JP01/00825, filed on 2/06/2001.

2) The information disclosure statement (I.D.S) filed 7/24/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant is required to submit a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed and new form PTO-1449 in next communication for consideration.

3) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

OPTICAL RECORDING MEDIUM INCLUDING IDENTIFICATION REGION  
CONSTITUTED PROTRUSIONS AND RECESSES SYMMETRICALLY.

4) Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the other" ( claims 1,6 and 7 ) render(s) the claim(s) indefinite since it was not clear what applicant intended to cover by the recitation "the other" information storage stripe. The resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired.

The phrase "long,narrow" ( claims 1,6 and 7 ) render(s) the claim(s) indefinite since all of the information storage stripes ( tracks ) in optical recording medium are considered "long,narrow".

The phrase "on average" ( claim 7 ) render(s) the claim(s) indefinite since the claim did not define how much " offset " of the groove/land could fit the definition of "on average".

Claim(s) 2-5 incorporate the indefiniteness of claim(s) 6 by virtue of their dependency thereon.

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

6) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7) (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8) Claims 1 and 3, as understood by the meaning of 112, 2<sup>nd</sup> above, are rejected under 35 U.S.C. 102(b) as being anticipated by KARUBE ( 5,604,726 ).

KARUBE discloses an information recording medium provided with a plurality of long, narrow information storage stripes each of which records data, as claimed in claim 1, comprising:

a data region where the data are recorded ( Fig.2, data region 10 ); and

an identification region where edges of the information storage stripe are protruded and recessed along the width of the information storage stripe according to identification information which distinguishes the long, narrow information storage stripe from the other long, narrow information storage stripes ( Fig.2, pre-format 20 includes disc ID ).

As to claim 3, KARUBE shows identification region constitutes tapered protrusions on edges toward center line of the information storage stripe ( Fig.2, the ID region 20 ).

9) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10) Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over KARUBE ( 5,604,726 ).

KARUBE discloses all the subject matter as claimed in claim 4, except to specifically show that the optical disc is magneto-optical disk or phase-change type optical disk. Examiner take Official Notice the fact that magneto-optical disk or phase-change type optical disk are known in the recording art to be equivalent to optical disk for storing information data. To substitute magneto-optical disk or phase-change type optical disk in KARUBE for the disclosed of optical disk as claimed would have been an obvious functional equivalent.

As to claim 5, the features of the information storage stripes (sectors) with land and groove arranged alternatively are old and widely in optical disk recording art.

11) Claims 1,2,4-7 are further rejected under 35 U.S.C. 102(e) as being anticipated by HORI et al ( 6,233,219 ).

HORI et al discloses an information recording medium provided with a plurality of long, narrow information storage stripes each of which records data, as claimed in claim 1, comprising:

a data region where the data are recorded ( Fig.1, data region 2 ); and

an identification region where edges of the information storage stripe are protruded and recessed along the width of the information storage stripe according to identification information which distinguishes the long, narrow information storage stripe from the other long, narrow information storage stripes ( Fig.1, address region 1 contains Disc ID information ).

As to claim 2, HORI et al shows the ID region constitutes protrusion and recesses arranged symmetrically on both edges of information storage stripe with respect to center line ( see figures 9 and 10, the protrusions and recesses are symmetrically on both edges of the tracks ).

As to claim 4, HORI et al shows that the optical disc is magneto-optical disk or phase-change type optical disk ( column 1, lines 15-34 ).

As to claim 5, HORI et al shows the features of the information storage stripes (sectors) with land and groove arranged alternatively ( column 15, lines 13-22 ).

Claim 6 adds to claim 1 the features of land and groove arranged alternatively, which is shows in HORI et al's column 15, lines 13-22.

Claim 7 adds to claim 1 the features of a land identification section where the boundary between the land track and groove track is offset to the land track on average and a groove identification section where the boundary between the land track and groove track is offset to the groove track on average, which is shown in HORI et al's figure 13, land identification section 12, boundary region 127 and groove identification section 11.

12) Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over HORI et al (6,233,219).

HORI et al discloses all the subject matter as claimed in claim 3, except to specifically show that the identification region constitutes tapered protrusions on edges toward center line of the information storage stripe. However, this feature is old and widely used in the optical recording art as shown in KARUBE's figure 2, ID region 20 above. Therefore, to use an identification region constitutes tapered protrusions on edges toward center line as claimed is deemed obvious to someone within the level of skill in the art.

13) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable



arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

14) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571)-272-7586. The examiner can normally be reached on MONDAY-FRIDAY from 8:00AM to 5:30PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH  
PRIMARY EXAMINER

August 30, 2006